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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,626	05/31/2000	Zubair Mirza	602927.090085	4023
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ABELMAN, FRAYNE & SCHWAB 666 THIRD AVENUE, 10TH FLOOR NEW YORK, NY 10017			EXAMINER SPISICH, MARK	
			ART UNIT 1744	PAPER NUMBER
DATE MAILED: 11/17/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,626

Applicant(s)

MIRZA ET AL.

Examiner

Mark Spisich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,10-13,19-26 and 31-45 is/are pending in the application.
- 4a) Of the above claim(s) 10-13,19-24,26,35-37,40 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,25,31-34,38,39 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Comment RE Non-elected Claims

Applicant elected to prosecute the embodiment of figure 11. As such, claims 10-13, 19-24, 26, 35-37 and 40 are withdrawn from consideration. In addition, claims 10-13 and 19-24 depend either directly or indirectly from canceled claims. In addition, applicant is only entitled to consideration of claims to additional species **which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided for by 37 CFR 1.141.** There is no generic claim present in the application (eg, claims 31, 38, 39, or 41), so even if (for argument sake) claim 31 was deemed to be allowable, the claims to the non-elected species (the claims recited the embodiment with the bi-stable spring) would have to be canceled.

Comment RE Claim 45

Applicant has indicated that claim 45 read on the elected embodiment (Figure 11). Figure 11 does have a spring-biased ball 66; however, this element is not “a resilient spring element **extending from one end of the handle and head parts and releasably engaging the other**”. This claim would appear to be drawn to the embodiment of Figure 12 and thus claim 45 is also withdrawn from consideration.

Claim Rejections - 35 USC § 112

1. Claims 7, 8, 25, 31-34, 38, 39 and 41-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. Applicant has amended the claims to recite a **motorless** toothbrush. Any negative limitation of exclusionary proviso must have basis in the original disclosure. MPEP 2173.05(i). There is no indication in the original disclosure that the exclusion of a motor was considered to part of applicant's invention. Absent a statement that the disclosed toothbrush excluded a motor, the added negative limitation thus constitutes new matter.

2. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. New claim 31 includes a recitation of a hinge as well as a recitation of a "catch means for releasably holding said head part in said first orientation" (claim 31, lines 12-13). Claim 25, which is dependent on claim 31, includes a recitation of a "restraining means" (claim 25, line 6). These two recitations are the same element and thus constitute an improper double inclusion of the same element.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 25,31-34,38 and 39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hukuba (USP 5,406,664). The patent to Hukuba discloses a toothbrush including a handle (12), head (10) with bristles (14) extending from the head, a pivot (58) between the head and the handle and

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further wherein the head, upon application of a predetermined force (P2) will automatically pivot from a first orientation (alpha 1) to a second orientation (alpha 2)..

With particular reference to the embodiment of figures 11-13, the hinge of Hukuba further includes a "catch means" or spring-biased ball (64,66) for retaining the head in the first orientation until the application of an excessive force to the bristles (column 8, line 46 thru column 9, line 20). When the ball (66) is between adjacent concave portions (68), the head would "freely flop". With regard to the limitation "motorless", the patent to Hukuba includes numerous recitations of the same passage and, in particular with regard to the embodiment of figures 11-13, states that "it should be understood that: this embodiment also includes a grip portion 12 replaced with a grip of an ordinary toothbrush" (column 9, lines 18-20). This is interpreted as a teaching that this aspect of the invention could also be practiced in a non-motorized toothbrush. Also, the provision of the brush head moving upon the application of excess pressure applied at the bristles is unrelated to the brush being a motorized brush anyway. Even for argument sake, the omission of an element and its function is obvious if the function of the element is not desired. In addition, the presence of or the omission of a motor does not affect the operative of the hinge means. In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) and In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). MPEP 2144.04.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7,8 and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hukuba (USP 5,406,664). The patent to Hukuba discloses the invention substantially as claimed (see above), and further discloses a head position (alpha 2) which is aligned with the longitudinal axis of the handle (12) as well as a head position (alpha 3) which is inclined rearward of the longitudinal axis (see figure 13). The particular angular increment (eg, 10 degrees in claim 41) would amount to an obvious choice of design. Also, the particular force amount would be obvious to one of ordinary skill depending on the desired brushing force.

Response to Arguments

7. Applicant's arguments filed 7 September 2006 have been fully considered but they are not persuasive. With regard to the recitation of "motorless", the patent to Hukuba (USP 5,406,664) includes a statement that the structure of figures 11 and 12 can be utilized with a grip of an ordinary toothbrush (column 9, lines 18-20). This is interpreted as implying that this aspect of the invention of Hukuba need not be practiced on a powered toothbrush. The elimination of the motor with the retention of the different head positions would nonetheless be obvious as the elimination thereof would not effect this aspect of the invention. With regard to the structure of Figures 11-12 of Hukuba, the toothbrush includes (1) a hinge (58); (2) a number of concave recesses (68) which are equivalent to the same elements (67a,67b) of the present application; and (3) a spring biased member (64) for engagement with the recesses (68) which is equivalent to the raised ball (66) of the present invention. This structure enables the head to be

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retained in a first orientation (either alpha 1 or alpha 2) and then to move backward upon application of a predetermined force to a second orientation (either alpha 2 or alpha 3). This is essentially the same structure as that in figure 11 of the present application. Intermediate positions of the ball (64) between adjacent recesses (68) would enable the head to "freely flop".

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (5:30-3:00), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mark Spisich
Primary Examiner
Art Unit 1744

MS